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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,385	05/16/2001	Donald R. Ryan	D/A0477Q3	3417
7590	08/03/2005		EXAMINER	RIES, LAURIE ANNE
Patent Documentation Center Xerox Corporation Xerox Square 20th Floor 100 Clinton Ave. S. Rochester, NY 14644			ART UNIT	PAPER NUMBER
2176				
DATE MAILED: 08/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/858,385	RYAN ET AL.
	Examiner	Art Unit
	Laurie Ries	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 May 2005.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-11 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 May 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This action is responsive to communications: amendment, filed 16 May 2005, to the original application, filed 16 May 2001.
2. The rejection of claims 1-2 and 8-11 under 35 U.S.C. 103(a) as being unpatentable over Tonkin (U.S. Publication 2005/0015392 A1) in view of Betts (U.S. Patent 5,428,694) has been withdrawn as necessitated by amendment and newly found prior art.
3. The rejection of claims 3-7 under 35 U.S.C. 103(a) as being unpatentable over Tonkin (U.S. Publication 2005/0015392 A1) in view of Betts (U.S. Patent 5,428,694) and Yankovich (U.S. Patent 6,704,906 B1) has been withdrawn as necessitated by amendment and newly found prior art.
4. Claims 1-11 are pending. Claims 12-35 have been withdrawn. Claim 1 is an independent claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-2 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin (U.S. Publication 2005/0015392 A1) in view of Allen (U.S. Patent 6,549,299 B1).

**As per claims 1 and 2,** Tonkin discloses a method for associating electronic data files to particular document components of a document including creating a document node as a parent document (See Tonkin, Figure 6, element 480, and Pages 5-6, paragraph 0071), creating a document component node as a sub-node of the document node (See Tonkin, Figure 6, element 500), and associating an electronic data file with the document component node (See Tonkin, Figure 5B, element 312, and Page 4, paragraphs 0054-0056). Tonkin does not disclose expressly selecting one of a set of at least seven document forms to apply to the document. Allen discloses a set of document forms that can be applied to documents, which shows, by way of example, seven different forms, including locations of folds, binding details, paper size, trimming details, number of pages in each document, page numbers of individual pages in a sequence, paper thickness, etc (See Allen, Column 3, lines 12-27). Tonkin and Allen are analogous art because they are from the same field of endeavor of processing electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the set of document forms of Allen with the method of Tonkin. The motivation for doing so would have been to indicate information about the finishing job (See Allen, Column 3, lines 34-43). Therefore, it would have been obvious

to combine Allen with Tonkin for the benefit of indicating information about the finishing job to obtain the invention as specified in claims 1 and 2.

**As per claim 8**, Tonkin and Allen disclose the limitations of claim 1 as described above. Tonkin also discloses prompting a user to classify the document as one of a set including a variable component and a static component (See Tonkin, Pages 5-6, paragraphs 0070-0071 and 0073-0075).

**As per claim 9**, Tonkin and Allen disclose the limitations of claim 8 as described above. Tonkin also discloses prompting the user to designate data address information to enable accessing of variable data during processing of the variable component (See Tonkin, Figure 5D, elements 382 and 385, and Page 5, paragraph 0061).

**As per claim 10**, Tonkin and Allen disclose the limitations of claim 1 as described above. Tonkin also discloses allowing a user to classify the document component as one of a set including an external component and an internal component, as shown by Tonkin as production components and document components, respectively (See Tonkin, Figure 6, and Page 6, paragraph 0076).

**As per claim 11**, Tonkin and Allen disclose the limitations of claim 10 as described above. Tonkin also discloses prompting the user for an integrity descriptor for the external component (See Tonkin, Figure 5D, elements 382 and 385, and Page 5, paragraph 0061).

6. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin (U.S. Publication 2005/0015392 A1) in view of Allen (U.S. Patent 6,549,299 B1)

as applied to claim 1 above, and further in view of Yankovich (U.S. Patent 6,704,906 B1).

**As per claim 3**, Tonkin and Allen disclose the limitations of claim 1 as described above. Tonkin and Allen do not disclose expressly applying to the electronic data file rules determined by selection of the document form. Yankovich discloses applying business rules to a file that are determined by the particular form selected (See Yankovich, Figure 4, Column 3, lines 50-67, and Column 4, lines 1-9). Tonkin, Allen, and Yankovich are analogous art because they are from the same field of endeavor of processing electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the rules of Yankovich with the method of Tonkin and Allen. The motivation for doing so would have been to determine the form flow or routing associated with the purpose of a particular form (See Yankovich, Column 3, lines 63-66). Therefore, it would have been obvious to combine Yankovich with Tonkin and Allen for the benefit of determining the form flow or routing associated with the purpose of a particular form to obtain the invention as specified in claim 3.

**As per claims 4 and 5**, Tonkin, Allen, and Yankovich disclose the limitations of claim 3 as described above. Tonkin also discloses classifying the document component into one of a set of document component types that are permitted under the form rules for the selected document form and verifying that the document component conforms to the form rules for the document component type into which the document component has been classified (See Tonkin, Page 5, paragraph 0070).

**As per claim 6**, Tonkin, Allen, and Yankovich disclose the limitations of claim 4 as described above. Tonkin also discloses prompting a user of the controller to input required attributes for the document component type into which the document component has been classified (See Tonkin, Figure 5B, and Page 4, paragraphs 0054-0055).

**As per claim 7**, Tonkin, Allen, and Yankovich disclose the limitations of claim 4 as described above. Tonkin also discloses displaying a list of each of the document component nodes created as sub-nodes of the document node together with an indication of the document component type into which the contents of each document component node has been classified (See Tonkin, Figure 5F, and Page 5, paragraphs 0065-0066).

### ***Response to Arguments***

7. Applicant's arguments filed 16 May 2005 have been fully considered but they are not persuasive. Applicant argues on Page 8 of the Instant Amendment that Tonkin fails to disclose the association of a data file with a component node. The Office respectfully disagrees. Tonkin shows in Figure 5B a document node, named "Test", which is associated with a file named "Volvo". The document node "Test" represents at least a portion of a document (See Tonkin, Figure 5B, and Page 4, paragraphs 0054-0056).

8. Applicant's arguments with regard to the teachings of document forms as presented on Page 9 of the Instant Amendment have been fully considered and are

persuasive, however, upon further consideration, a new ground of rejection is made in view of Allen (U.S. Patent 6,549,299 B1).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Buis (U.S. Patent 6,631,007 B1) discloses a system and method for presenting multiple sheetlets on a medium surface while presenting multiple logical pages within the sheetlets.
- Tervonen discloses an integrated computer aided design, documentation and manufacturing system for PCB electronics.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

*William F. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
8/1/2005